REMARKS

Claims 1 to 8 are pending in present application. Claims 1 to 3 have been rejected under 35 U.S.C. § 112 second paragraph and 35 U.S.C. § 102(b). Additionally, claims 4 to 8 have been withdrawn from consideration due to a restriction requirement. As a consequence, claims 4 to 8 have been canceled by Applicants; however, Applicants' reserve their right to pursue the canceled claims in divisional applications. Claims 1 and 3 have been amended, and the rejections to claims 1 to 3 are traversed below. By way of these amendments no new matter has been added.

Rejection of Claims 1 to 3 under 35 U.S.C. § 112 second paragraph

The Examiner rejected claims 1 and 3 under 35 U.S.C.§ 112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The Examiner objects to the term "derivatives" found in claims 1 and 3. Applicants have amended claims 1 and 3 by deletion of the term "derivatives" from said claims. Therefore, based upon these amendments applicants respectfully request withdrawal of the rejection to claims 1 and 3 as being indefinite under 35 U.S.C. § 112 second paragraph.

Rejection of Claims 1 to 3 under 35 U.S.C. § 102(b)

Claims 1 to 3 were rejected under 35 U.S.C. § 102(b) as being anticipated by Webster et al. (U.S. 6,316,476) or Chen et al. (WO 99/12543). Claims 1 to 3 of the instant invention disclose a novel method of treating CNS disorders by administering pharmaceutical compositions containing certain thiolutin compounds to a patient. According to the Examiner, even though Webster or Chen does not disclose each and every limitation of the Applicants' claims, the mere fact that Webster or Chen discloses the use of a pharmaceutical composition of thiolutin compounds to treat specific medical disorders (infections or cancer), it must follow that Webster or Chen anticipates the Applicants' invention (treatment of CNS disorders). The Examiner bases her argument upon the concept of inherency, arguing that once the prior art discloses that a pharmaceutical composition is useful in treating a specific type of disease, consequently treating any type of disease becomes an inherent property of that pharmaceutical composition. And, a disclosure need not be express and becomes anticipatory even if those skilled in the art fail to recognize the inherent property. The Examiner relies upon court decisions rendered in *Atlas Powder Co. v. IRECO, Inc.*, and *Ex parte Novitski* for support of her stand.

Applicants have amended claim 1 to eliminate the phrase "pharmaceutical composition". Thus, the claim now reads exclusively as a new method of treatment with the compound of formula 1. No new matter has been added by this amendment and support can be found in the specification

on page 3, line 006. By way of this amendment Applicants' are of the opinion that the anticipation rejection under 102(b) has been overcome. The Federal Circuit has opined in *Atlas Powder Co. v. IRECO 51USPQ2d 1943* (Fed. Cir. 1999) "[that] if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art." Or another way of looking at the issue is to ask: Would the prior art infringe the claims of the instant invention? It is respectfully suggested that by doing the above analysis vis-à-vis the Webster or Chen references and the amended claims of the present application that one can conclude that the prior art does not anticipate the Applicants' invention.

In addition, the Examiner has misconstrued the inherency analysis and misapplied the same to the instant case. That is, what the Applicants teach in the instant case is to treat a CNS disorder in a patient using compound of formula I. As admitted by the Examiner, neither Webster nor Chen teaches that the compound of formula I can be used to treat a CNS disorder. Thus obviously there is no anticipation. But most importantly what the Examiner has missed is that the patient population of the instant application is much different from the patient population used by the prior art. Thus there is no inherency. As stated by a court: "Anticipation is established if every element of a properly construed claim is present in a single prior art reference. See Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc. 45 F.3d 1550, 1554 (33 USPQ2d 1496) (Fed. Cir. 1995)."

From the foregoing analysis it is clear that what prior art teaches is much different from what is taught in the instant application. Therefore, clearly, there is no anticipation.

Even more importantly, arguendo, if Examiners assertions are considered to be correct there will never be a patent issued on a novel use of a known compound thus depriving a well deserved applicant a patent. Definitively, this is not the intention of the Congress and/or the framers of our Constitution who provided for a patent protection with the intention of promoting the growth of science and technology.

Applicants would like to bring to the Examiner's attention two press releases (see attached) that show patents for new uses of drugs are granted and their value to the patient community. One describes the use of prozac to treat PMS (see U.S. Patent No. 5,223,450) and another for the use of calcium channel blockers for the treatment of schistosomiasis (see U.S. Patent No. 6,514,963). Removing incentives to search for new therapeutic uses of known drugs by denying exclusionary rights to inventors would, in Applicants opinion, be detrimental to the advance of medicine, and not the intent of the patent laws.

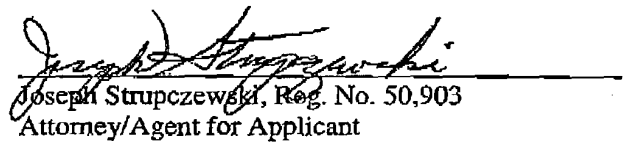
In view of all of the arguments advanced above, Applicants respectfully submit that claims 1 to 3 fully satisfy the requirements of 35 USC § 102(b), and therefore, request withdrawal of rejection as to claims 1 to 3.

Conclusion

In view of the Amendments and Remarks presented herein Applicants respectfully submit that the claims 1 to 3 are now in condition for allowance and respectfully request a notice to this effect. Should the Examiner have any questions please call (collect if necessary) the undersigned attorney at the telephone number listed below.

Applicant believes that there are no fees due for this Rule 111 Amendment. However, if the Commissioner deems that fees are due, please charge these fees to Deposit Account No. **18-1982** for Aventis Pharmaceuticals Inc., Bridgewater, NJ. Please credit any overpayment to Deposit Account No. **18-1982.**

Respectfully submitted,



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Aventis Docket No. DEAV2001/0015 US NP

Attachments: Press release: *Scientists Patent Prozac Use For PMS* (2 pages) and press release: *UCSB donates Patent Rights for Novel Use of Heart Drugs to Combat Global Parasitic Disease* (2 pages).